

Docket No.: 064162-0030



PATENT

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of : Customer Number: 20277
Michael L ROONEY : Confirmation Number: 5087
Application No.: 10/757,848 : Group Art Unit: 1714
Filed: January 16, 2004 : Examiner: Anthony, Joseph David
For: OXYGEN SCAVENGERS INDEPENDENT OF TRANSITION METAL CATALYSTS

PETITION FOR SUPERVISORY REVIEW
UNDER 37 C.F.R. § 1.181(a)(3)

Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Petitioner requests that the Director of the USPTO exercise his supervisory authority to require the Examiner in the above-referenced patent application to retract the allegation that Applicant's argument traversing a restriction requirement is "totally false." The request is based on the following facts.

On October 5, 2006, the Examiner made a restriction requirement and required an election of species. In the requirement, the Examiner stated the following as a basis for the restriction:

Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product

or (2) the product as claimed can be used in materially different process of using that product. In the instant case the product as claimed can be used in an ink composition.

On December 11, 2006, Applicant elected an invention and a species, and traversed the rejection. The basis for the restriction was unclear because the example given by the Examiner did not appear fit either items (1) or (2), *supra*. With respect to item (1), if the ink composition is a materially different product, the Examiner did not state that it could be used in the claimed process. With respect to item (2), an ink composition is not a materially different process. In traversing the restriction, Applicant made the following argument:

The two groups of claims are related as product and process of use, and therefore, at the very least, the process claims should be rejoined in the application upon allowance of the product claims. As such, the Examiner's assertion that the process can be carried out with another product is incorrect. The method claims specifically recite a product as set forth in the product claims. Therefore, restriction is improper and should be withdrawn.

On March 4, 2007, the Examiner mailed a Notice of Incomplete Response and responded to the argument as follows:

... applicant [sic, applicant's] traversal of the restriction requirement that: "As such the Examiner's assertion that the process can be carried out with another product is incorrect." Is [sic, incorrect" is] deemed to be **totally false** since the examiner never made any such assertion in the written restriction requirement! [Emphasis added].

The use of the term "totally false" to characterize Applicant's argument raises a serious issue that could lead to an accusation of inequitable conduct. Such an accusation would have serious adverse implications if the patent application should issue as a patent and Applicant seeks to enforce or license the patent. While the statement made by the Examiner could be regarded as

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an inadvertent mischaracterization of the argument, a court or potential licensee may not see it in that light.

In responding to the Notice of Incomplete Response on March 21, 2007, the Petitioner requested that the Examiner either point out how and why the statement would be characterized as being "totally false" or withdraw the accusation. In an Office Action dated June 17, 2007, the Examiner maintained his position because the basis for making the restriction was that "the product as claimed can be used in an ink composition." This reason, however, does not render Applicant's argument traversing the restriction as being "totally false." The argument may be unpersuasive, but it is not "totally false."

It is requested that the Director use his supervisory authority to review the file history. If he is of the opinion that the Examiner's use of the term "totally false" was inappropriate under the circumstances, it is requested that the Director remove from the record any implication that Applicant made a "totally false" statement.

Please charge any shortage in fees due under 35 U.S.C. § 1.17 in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,
McDERMOTT WILL & EMERY LLP


Cameron K. Weiffenbach
Registration No. 44,488
**Please recognize our Customer No. 20277
as our correspondence address.**

600 13th Street, N.W.
Washington, DC 20005-3096
Phone: 202.756.8000 CKW:ckw
Facsimile: 202.756.8087
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